



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/972,181	10/05/2001	Dusan Miljkovic	700.03-USI	3749

34284 7590 06/25/2004

ROBERT D. FISH; RUTAN & TUCKER, LLP
P.O. BOX 1950
611 ANTON BLVD., 14TH FLOOR
COSTA MESA, CA 92628-1950

EXAMINER

OH, TAYLOR V

ART UNIT	PAPER NUMBER
----------	--------------

1625

DATE MAILED: 06/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/972,181	Applicant(s) MILJKOVIC, DUSAN	
	Examiner Taylor Victor Oh	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7,8,14 and 17-20 is/are rejected.
- 7) ☐ Claim(s) 6,9-13,15 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/5/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1625

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

The Status of Claims

Claims 1-20 are pending.

Claims 1-5, 7-8, 14, and 17-20 are rejected.

Claims 6, 9-13, and 15-16 are objected.

Claims 6, 9-13, and 15-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5, 7-8, 14, 17, 18-19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the terms "an oxidizable compound", "an electrophilic compound", "an electron donating group", "a complex", and "a second stability towards the oxidation" are recited. They are vague and indefinite because the claims do not define what each of them is with respect to its chemical structure

Art Unit: 1625

and its functional group ; and furthermore, it is uncertain as to how they are arranged with respect to their spatial arrangement among the electrophilic compound and the electron donating group by forming the complex. Moreover, the phrase "a second stability towards the oxidation" is unclear because there is no description in the claim as to how the first stability is different from the second stability. Therefore, an appropriate correction is required.

In claim 2, the phrase " R' and R" optionally comprise" is recited.

The expression is vague and indefinite because " R' and R" optionally comprise" would mean that there are other additional components besides the only R' and R" group. Therefore, an appropriate correction is required.

In claim 3, the phrases " the oxidizable compound further comprises" and " a first electron donating group and a second electron donating group" are recited. The expressions are vague and indefinite. This is because "the oxidizable compound further comprises" would mean that there are other additional components besides the only oxidizable compound ; furthermore, there is uncertain as to what they are respectively and which the electron donating group is the first one relative to the second electron donating group in the structurally unknown oxidizable compound. Therefore, an appropriate correction is required.

In claim 4, the phrases " the electron donating group and a second electron donating group" are recited. The expressions are vague and indefinite. This is because there is uncertain as to which the electron donating group is

Art Unit: 1625

the first one relative to the second electron donating group in the structurally unknown oxidizable compound. Therefore, an appropriate correction is required.

In claim 5, the phrases " the electron donating group" and " the oxidizable compound" are recited. The expressions are vague and indefinite. This is because there is uncertain as to which the electron donating group is and what the structurally unknown oxidizable compound is. Therefore, an appropriate correction is required.

In claim 7, the phrase " the electron-donating group comprises " is recited. The expression is vague and indefinite because " the electron-donating group comprises " would mean that there are other additional components besides the only the electron-donating group. Therefore, an appropriate correction is required.

In claims 8, 19, and 20, the phrase " the electrophilic compound comprises " is recited. The expression is vague and indefinite because " the electrophilic compound comprises " would mean that there are other additional components besides the only " the electrophilic compound. Therefore, an appropriate correction is required.

In claim 14, the phrase " the oxidation comprises a reaction of an alcohol group in the oxidizable compound into a keto group in an aqueous system" is recited. The expression is vague and indefinite because " the oxidation " is the

Art Unit: 1625

reaction process defined by oxidizing the alcohol group of the oxidizable compound into the keto group in the aqueous system. The term "comprises" implies other oxidation steps or procedures besides the only oxidation process.

In claim 17, the terms "a compound", "an oxidizable compound", "an electrophilic compound", "an electron donating group", and "a complex" are recited. They are vague and indefinite because the claims do not define what each of them is with respect to its chemical structure and its functional group; and furthermore, it is uncertain as to how they are arranged with respect to their spatial arrangement among the electrophilic compound and the electron donating group by forming the complex. Moreover, the phrase "a second stability is greater than the first stability" is unclear because there is no description in the claim as to how much the second stability is greater than the first stability. Therefore, an appropriate correction is required.

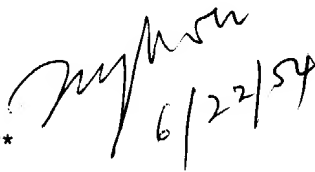
In claim 18, the phrases "the electron donating group and a second electron donating group" are recited. The expressions are vague and indefinite. This is because there is uncertain as to what they are respectively and which the electron donating group is the first one relative to the second electron donating group in the structurally unknown oxidizable compound. Therefore, an appropriate correction is required.

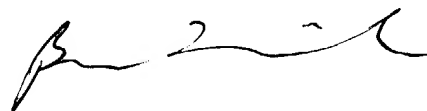
Art Unit: 1625

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached from 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Mckane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


6/22/54



BA K. TRINH
PRIMARY EXAMINER
GROUP 1200 1625